



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,314	08/21/2003	Yuh-Shen Song	7443-103	9778
167 7590 08/23/2007 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			EXAMINER BASIT, ABDUL	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/646,314	Applicant(s) SONG ET AL.	
	Examiner Abdul Basit	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/21/003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 11, 30-34, 36, and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Doggett (US Pat. No. 5,677,955).

Regarding claim 1:

Doggett teaches a computerized method for verification and processing of a financial transaction using a documentary payment instrument to effect a transfer of funds from a payer's financial institution account to a payee's financial institution account, comprising:

- Opening an account for a payer in a networked financial center after authenticating the payer's identity, payer's financial institution and the specific account at that institution; *(see column 3 generally)*.
- Again authenticating the payer's identity before the payer can register a payment instrument with the networked financial center; *(see column 3, lines 40-45)*
- Guiding the payer through a payment instrument registration process in which the payee's name, identification information, and transaction amount is entered into a database of the networked financial center; *(see column 3, lines 55-59)*.
- Issuing a unique Transaction Identification Number for the registered payment instrument; *(see column 4, lines 5-6)*.

- Authenticating the payee's identity before the payee can perform any transaction with the networked financial center; (see *column 4, lines 1-10*)
- Once the payee's identity has been authenticated, using the Transaction Identification Number to access the database of the networked financial center in order to verify that the payee's identity and the transaction amount on the payment instrument match the payee information and the transaction amount registered by the payer into the database of networked financial center; (see *column 4, lines 1-20*) and
- If the verification is successful and the specified transaction funds are available, causing the funds to be transferred to the payee's financial institution account. (see *column 4, lines 1-20*).

Regarding claim 2:

Doggett further teaches that the method of claim 1 further comprises using a machine-readable official identification card to open the payer's account with the networked financial center, wherein the account is opened only if the embedded identification information read from the payer's identification card matches the account holder information of the financial account identified by the payer. (see *column 5, lines 38-43*).

Regarding claim 3:

Doggett further teaches that the method of claim 2 further comprises:

- Prompting the payer to input an additional item of personal information not embedded in the identification card but stored in the remote database of the financial institution; (see *column 3 generally*) and

- Verifying that the additional personal information input by the payer matches the personal information stored in the remote database. *(see column 3 generally)*

Regarding claim 4:

Doggett further teaches that the method of claim 3, wherein the personal information input by the payer includes at least part of a social security number. *(see column 4, lines 5-6).*

Regarding claim 11:

Doggett teaches that the method of claim 1 further comprises using a machine-readable official identification card to register payment instrument information with the networked financial center, wherein the information is registered only if the embedded identification information read from the payer's identification card matches the account holder information of the financial account identified by the payer. *(see column 5 generally).*

Regarding claim 20:

Doggett teaches that claim 1 further comprises:

- Permitting the payee to request payment directly from a networked remote *(see column 5 generally)*
- Service depot terminal equipped with a device for reading the payee's machine-readable official identification card; *(see column 5 generally)*
- Verifying that the payee's identification information read from the official identification card matches the payee information entered by the payer into the database; *(see column 5 generally)* and

- If the verification of the payee's identity is successful and the transaction funds are available, issuing the payment directly to the payee from the networked remote service depot terminal. *(see column 5 generally)*

Regarding claim 30:

Doggett teaches that for the method of claim 1, the payment documents include paper checks. *(see column 5 generally)*.

Regarding claim 31:

Doggett teaches that for the method of claim 1, the payment documents include letters of credit. *(see column 5 generally)*.

Regarding claim 32:

Doggett teaches that for the method of claim 1, wherein the payment documents include notes. *(see column 5 generally)*.

Regarding claim 33:

Doggett teaches that for the method of method of claim 1, the payment documents include other payment-oriented financial documents. *(see column 5 generally)*.

Regarding claim 34:

Doggett teaches that for the method of claim 20, the remote depot terminal is installed in a regular office under the supervision of personnel appointed by the networked financial center. *(see column 3, lines 8-10)*.

Regarding claim 35:

Doggett teaches that for method of claim 1, wherein the transaction funds associated with the unique Transaction Identification Number are electronically transferred from the

specified payer's account at the specified payer's financial institution to an account maintained by the networked financial center prior to divulging that unique Transaction Identification Number to either the payer or the payee. *(see column 5 generally)*

Regarding claim 36:

Doggett teaches that for the method of claim 1, wherein the unique Transaction Identification Number is marked on the payment document in a machine-readable format. *(see column 10 generally)*.

Regarding claim 38:

Doggett teaches that the method of claim 1 further allows for the permitting the payer's financial institution to open an account in the networked financial center on behalf of the payer. *(see column 5, lines 21-25)*.

Regarding claim 39:

Doggett teaches that the method of claim 38 further allows for the payer's account in the networked financial center opened by the payer's financial institution is linked to a specific payer's account of that financial institution. *(see column 5, lines 21-25)*.

Regarding claim 40:

Doggett teaches that for the method of claim 1, where the networked financial center is established exclusively for one financial institution to provide services to the customers of the financial institution. *(see column 5, lines 21-25)*.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-6, 9-10, 14-15, 18-19, 23-24, and 27-28 are rejected under 35

U.S.C. 103(a) as being unpatentable over Doggett in view of Uberti (US Pub. No. 2003/0046237).

Regarding claim 5:

Uberti, not Doggett, teaches that the method of claim 3, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 6:

Uberti, not Doggett, teaches that the method of claim 5, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 9:

Uberti, not Doggett, teaches that the method of claim 7, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 10:

Uberti, not Doggett, teaches that the method of claim 9, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 14:

Uberti, not Doggett, teaches that the method of claim 12, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 15:

Uberti, not Doggett, teaches that the method of claim 14, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

Art Unit: 3694

Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 18:

Uberti, not Doggett, teaches that the method of claim 16, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 19:

Uberti, not Doggett, teaches that the method of claim 18, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 23:

Uberti, not Doggett, teaches that the method of claim 21, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom

line.

Regarding claim 24:

Uberti, not Doggett, teaches that the method of claim 23, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 27:

Uberti, not Doggett, teaches that the method of claim 25, wherein the personal information input by the payer includes at least biometric information. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

Regarding claim 28:

Uberti, not Doggett, teaches that the method of claim 27, wherein the biometric information input by the payer includes at least a fingerprint. (*see abstract*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Uberti. Motivation to modify exists because biometric information allows for reduced levels of fraud which enhances a corporations bottom line.

5. Claims 7, 12, 16, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Fox (US Pat. No. 6,842, 863)

Regarding claim 7:

Fox, not Doggett, teaches that claim 2 further comprises:

- Prompting the payer to input an additional item of personal information embedded in the identification card but not stored in the remote database of the financial institution; (*see column 6 generally*) and
- Verifying that the additional personal information input by the payer matches the personal information embedded in the identification card. (*see column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Fox. Motivation to modify exists because verification helps to reduce fraud which reduces operational costs for a business.

Regarding claim 12:

Fox, not Doggett, teaches that claim 11 further comprises prompting the payer to input an additional item of personal information not embedded in the identification card but stored in the database; and verifying that the additional personal information input by the payer matches the personal information stored in the database. (*see column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Fox. Motivation to modify exists because verification helps to reduce fraud which reduces operational costs for a business.

Regarding claim 16:

Fox, not Doggett, teaches that claim 11 further comprises:

- Prompting the payer to input an additional item of personal information embedded in the identification card but not stored in the database; (*see column 6 generally*) and
- Verifying that the additional personal information input by the payer matches the personal information embedded in the identification card. (*see column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Fox. Motivation to modify exists because verification helps to reduce fraud which reduces operational costs for a business.

Regarding claim 21:

Fox, not Doggett, teaches that claim 20 further comprises:

requesting the payee to input an additional item of personal information not embedded in the identification card but stored in the database; and verifying that the additional personal information input by the payee matches the personal information stored in the database. (*see column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Fox. Motivation to modify exists because verification helps to reduce fraud which reduces operational costs for a business.

Regarding claim 25:

Fox, not Doggett, teaches that method of claim 20 further comprising:

- Prompting the payee to input an additional item of personal information embedded in the identification card but not stored in the database, (*see column 6 generally*) and
- Verifying that the additional personal information input by the payee matches the personal information embedded in the identification card. (*see column 6 generally*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Fox. Motivation to modify exists because verification helps to reduce fraud which reduces operational costs for a business.

6. Claims 8, 13, 17, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Fox and in further view of Oyama (US Pub. No. US 2002/007343).

Regarding claim 8:

Oyama teaches that for the method of claim 7, the additional personal information input by the payer includes at least a personal identification number. (*see ¶ 27*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Oyama. Motivation to modify exists because input of a personal identification number helps to reduce fraud which reduces the expense of operating a business.

Regarding claim 13:

Oyama teaches that for claim 12, the personal information input by the payer includes at least part of a social security number. (*see ¶ 27*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Oyama. Motivation to modify exists because input of a personal identification number helps to reduce fraud which reduces the expense of operating a business.

Regarding claim 17:

Oyama teaches that for claim 16, wherein the additional personal information input by the payer includes at least a personal identification number. (see ¶ 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Oyama. Motivation to modify exists because input of a personal identification number helps to reduce fraud which reduces the expense of operating a business.

Regarding claim 22:

Oyama teaches that for claim 21, the personal information input by the payee includes at least part of a password. (see ¶ 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Oyama. Motivation to modify exists because input of a personal identification number helps to reduce fraud which reduces the expense of operating a business.

Regarding claim 26:

Oyama teaches that for method of claim 25, wherein the personal information input by the payee includes at least part of a password. (see ¶ 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Oyama. Motivation to modify exists because input of a personal identification number helps to reduce fraud which reduces the expense of operating a business.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Dutta (US Pub. No. 2002/0073008).

Regarding claim 29:

Dutta, not Doggett, teaches including an escrow agent into the transaction based on the agreement between payer and payee whereby the payee cannot receive payment unless the escrow agent has approved the payment first. (see ¶ 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Doggett with Dutta. Motivation to modify exists because the use of an escrow agent provides for a more efficient method of a monetary transaction between two separate entities.

8. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of Zhou (US Pat. No. 5,974,200).

Regarding claim 37:

Zhou, not Doggett, teaches that for the method of claim 36, the machine-readable format is optically scanable.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Zhou. Motivation to modify exists because this method does not require intensive manipulation of a pixel distribution over an entire image (see Zhou,

column 2, lines 22-25).

9. Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett in view of the article, Motorola and Mastercard form alliance to promote m-commerce (Business Wire, New York, July 18, 2000)

Regarding claim 41:

Motorola, not Dogget, teaches that for the method of claim 2:

- A wireless data transmission device is incorporated into the identification card;
(see pages 1-4)
- A wireless data receiver reads the machine-readable identification information of the identification card. (see pages 1-4)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Motorola. Motivation to modify exists because use of a wireless system will provide enhanced e-commerce capabilities for a user.

Regarding claim 42:

Motorola, not Doggett, teaches that for the method of claim 11:

- A wireless data transmission device is incorporated into the identification card;
(see pages 1-4)) and
- A wireless data receiver reads the machine-readable identification information of the identification card. (see pages 1-4)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Motorola. Motivation to modify exists because use of a wireless system will provide enhanced e-commerce capabilities for a user

Regarding claim 43:

Motorola, not Doggett, teaches that for the method of claim 20, wherein

- A wireless data transmission device is incorporated into the identification card;
(see pages 1-4) and
- A wireless data receiver reads the machine-readable identification information of the identification card. (see pages 1-4)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Doggett with Motorola. Motivation to modify exists because use of a wireless system will provide enhanced e-commerce capabilities for a user

Conclusion

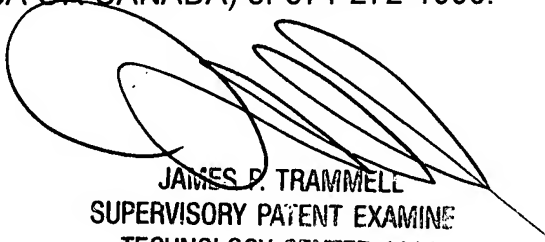
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes Ronen et al, Method for the Billing of Transactions over the Internet (US Pat. No. 5,905,736), Aieta et al., Systems and Methods for Guaranteeing the protection of private information (US Pat. No. 6,839,689), Ramzy, Check Fraud Prevention System (US Pat. No. 6,073,121), Fishman et al., System, process and article for conducting authenticated transactions (US Pub. No. 2002/0138765), Keech, Systems and Methods for identity verification for secure transactions (US Pub. No. 2002/0059146).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Basit whose telephone number is 571 272-7246. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

aqb



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 3602